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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,134	04/03/2001	David Wallach	WALLACH=16A	2547
1444	7590	02/25/2005	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C.			DAVIS, MINH TAM B	
624 NINTH STREET, NW			ART UNIT	
SUITE 300			PAPER NUMBER	
WASHINGTON, DC 20001-5303			1642	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/824,134	WALLACH ET AL.	
	Examiner	Art Unit	
	MINH-TAM DAVIS	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11, 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The finality of the previous Office action has been withdrawn, and the prosecution of this application is reopened to include a rejection not previously cited.

It is noted that applicant has paid for a Notice of Appeal. Applicant can either request a refund or place the funds on credit for future appeals.

Accordingly, claims 1-7, 11, 14 are being examined.

The following are the remaining rejections.

REJECTION UNDER 35 USC 101, DOUBLE PATENTING

35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245

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F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d). The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 of the instant application is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 29-31, 39, 42-46 of copending application Serial No. 08/860,082.

This is a *provisional* obviousness-type double patenting rejection since the conflicting claims have not in fact been patented.

The claim 1 in the present application is drawn to:

An isolated DNA molecule comprising:

- 1) a DNA sequence which encodes the MORT-1 protein, having the amino acid sequence of SEQ ID NO:2,
- 2) a DNA sequence which encodes an analog of said MORT-1 protein, which analog binds with the intracellular domain of the FAS ligand receptor (FAS-IC), which DNA sequence is capable of hybridization to the cDNA encoding SEQ ID NO:2 under moderately stringent conditions, or
- 3) a DNA coding sequence consisting of a DNA sequence which encodes a fragment of said MORT-1 protein, which binds with FAS-IC.

Claim 2 of the instant application is drawn to a DNA of claim 1, comprising a DNA sequence which encodes an analog of said MORT-1 protein, which analog binds with the intracellular domain of the FAS ligand receptor (FAS-IC), which DNA sequence is

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capable of hybridization to the cDNA encoding SEQ ID NO:2 under moderately stringent conditions.

Claims 3-7 of the instant application are drawn to:

- a) a vector comprising a DNA sequence of claim 1(claim 3), wherein said vector could be expressed in an eukaryotic (claim 4) or prokaryotic host cell (claim 5),
- b) an isolated transformed eukaryotic or prokaryotic host cell (claim 6) , and
- c) a method for producing a polypeptide that binds to the intracellular domain of the FAS-R, comprising growing the host cells of claim 6 (claim 7).

Claim 39 in the application SN 08/466,844 is drawn to:

- 1) a DNA sequence which encodes the MORT-1 protein, having the amino acid sequence of SEQ ID NO:2,
- 2) a DNA sequence which encodes an analog of said MORT-1 protein, which differs therefrom by a single amino acid residue and binds with the intracellular domain of the FAS ligand receptor (FAS-IC), or
- 3) a DNA coding sequence consisting of a DNA sequence which encodes a fragment of said MORT-1 protein, which binds with FAS-IC.

Claim 29 is drawn to a DNA molecule of claim 39, comprising a DNA sequence encoding the amino acid sequence of SEQ ID NO:2.

Claim 30 is drawn to a DNA molecule of claim 29, comprising the DNA sequence of SEQ ID NO:2.

Claim 31 is drawn to a DNA molecule of claim 39, comprising a DNA coding sequence consisting of a DNA sequence which encodes a fragment of said MORT-1 protein, which binds with FAS-IC.

Claims 42-46 of copending application Serial No. 08/860,082 are drawn to:

- a) a vector comprising a DNA sequence of claim 39 (claim 42), wherein said vector could be expressed in an eukaryotic (claim 43) or prokaryotic host cell (claim 44),
- b) an isolated transformed eukaryotic or prokaryotic host cell (claim 45), and
- c) a method for producing a polypeptide that binds to the intracellular domain of the FAS-R, comprising growing the host cells of claim 6 (claim 46).

It is noted that it seems that by typographic error claim 30 recites the DNA sequence of SEQ ID NO:2, which is an amino acid sequence. For the purpose of compact prosecution, it is assumed that claim 30 recites SEQ ID NO:1, and not SEQ ID NO:2.

The DNA molecule and fragment thereof of the copending application Serial No. 08/860,082 anticipate the DNA molecule and fragment thereof of the instant application, because they are drawn to the same DNA molecule and fragment thereof.

Further the analog of the copending application Serial No. 08/860,082 anticipates the analog the instant application, because the analog of the copending application Serial No. 08/860,082 is a species of the analog of instant application.

The vector, host cells, and a method for producing a polypeptide that binds to the intracellular domain of the FAS-R of the copending application Serial No. 08/860,082

anticipate the vector, host cells and a method for producing a polypeptide that binds to the intracellular domain of the FAS-R of the instant application.

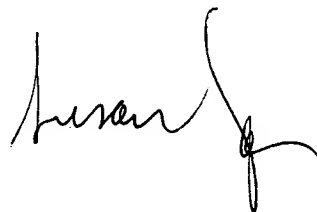
Thus, although the conflicting claims are not identical, they are not patentably distinct from each other because they relate to the same inventive concept.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY SIEW can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SUSAN UNGAR, PH.D
PRIMARY EXAMINER



MINH TAM DAVIS

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February 17, 2005